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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,977	08/20/2001	Stephen Proulx	MCA-449 PC/US	8230
29621	7590	12/23/2003	EXAMINER	
MYKROLIS CORPORATION 129 CONCORD ROAD BILLERICA, MA 01821-4600				POPOVICS, ROBERT J
		ART UNIT		PAPER NUMBER
		1724		

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/913,977	PROULX ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert J. Popovics	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 09 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-18 and 25-27 is/are pending in the application.  
4a) Of the above claim(s) 10-14, 18 and 25-27 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9 and 15-17 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ . 6)  Other: \_\_\_\_ .

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Slurry Species I (silica based) and End Cap Species I (Fig. 3) in Applicant's Response of September 9, 2003 is acknowledged. The traversal is on the ground(s) that there is a "**single generic concept [that] is the provision of a depth filter free of an open void volume upstream of the depth filter in order to remove undesirably large particles from the filter being filtered.**" This is not found persuasive because this argument does not address the mutually exclusive nature of the species claims. If a generic claim embodying Applicant's "**single generic concept**" is ultimately found to be allowable, then Applicant is entitled to rejoinder of the non-elected species claims.

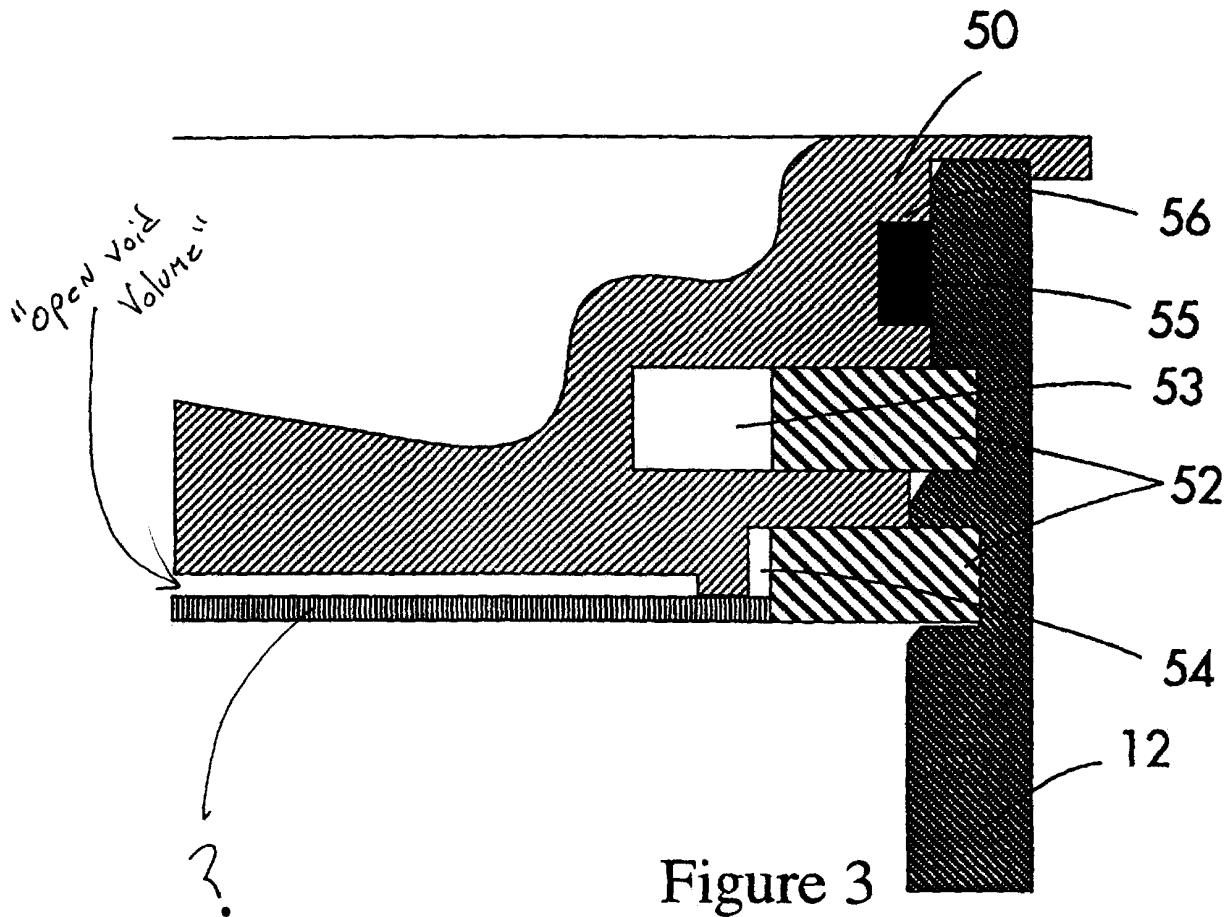
The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Below is Fig. 3 (the elected end cap species) taken from Applicant's specification.



**Figure 3 appears to have an “open void volume” as indicated by the handwritten arrow, yet Applicant’s “single generic concept is the provision of a depth filter free of an open void volume upstream of the depth filter in order to remove undesirably large particles from the filter being filtered.”** Since an open void volume appears to be clearly shown in the drawing, the disclosure is not commensurate with the scope of the claims, and does not enable one skilled in the art to practice the invention. Moreover, it is unclear what the unlabeled member beneath the open void volume, is (see arrow with question mark).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what Applicant intends by the recitation “**being free of an open void volume upstream of the depth filter.**” The elected end cap species (Fig. 3) appears to show an open void volume upstream of the depth filter (see the enablement rejection above). Thus, it is unclear what Applicant means by this language in the context used. Furthermore, the “inlet” and the “outlet” appear to constitute “open void volumes.” It is unclear if Applicant’s claims intend to exclude these volumes from the “hollow housing” volume. As drafted, the claims are seen to include the open void volumes of the inlet and outlet, and thus, present an inconsistency in the claim language. It is unclear where Applicant intends the “hollow housing” volume to end, and the inlet and outlet volumes to begin. As drafted, the meaning of the claims is unclear, since the housing has an inlet, which appears to constitute “an open void volume,” when the claim specifically precludes an open void volume from being upstream of the depth filter.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

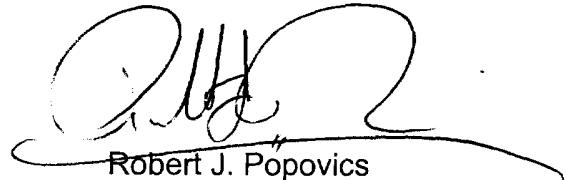
Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by **Ellefson (US 5,472,600)**. See columns 3-4, column 5, lines 10-15 and example 7.

***Response to Arguments***

Applicant's arguments filed 2/7/03 have been fully considered but they are not persuasive. Applicant has argued "**Ellefson et al. disclose a filtration cartridge having a void volume (36) upstream of the filter.**" The Examiner disagrees with Applicant. Volume 36 is seen to constitute the "inlet" of the Ellefson et al. filter.

This action is NOT FINAL.

Any inquiry concerning this communication should be directed to Robert J. Popovics at telephone number (571) 272-1164.



Robert J. Popovics  
Primary Examiner  
Art Unit 1724

December 15, 2003